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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,592	03/23/2004	Peter Collier	1367-28	2443

7590 07/03/2007
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EXAMINER

SPAHN, GAY

ART UNIT	PAPER NUMBER
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3635

MAIL DATE	DELIVERY MODE
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07/03/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/806,592	Applicant(s) COLLIER ET AL.	
	Examiner Gay Ann Spahn	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-57 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions - Restriction Requirement

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-19, 49 and 56, claims 20-36 and 57, claim 37, claim 38 and 39, claim 40, claim 41, claim 42, and claims 54 and 55, all drawn to the combination of a block and insulating element, classified in class 52, subclass 606.
- II. Claims 43 and 44, claims 45-48, and claims 50-53, drawn to a method of making a block, classified in class 264, subclass 259.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process such as the insulating element can be inserted subsequent to pouring at least some of the matrix or can be inserted after matrix is cured.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required

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because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Election/Restrictions - Election of Species Requirement

This application contains claims directed to THREE GROUPS OF SPECIES from each of which groups Applicants must elect a single species.

The FIRST GROUP OF SPECIES (i.e., species of insulating element) from which Applicants must elect a single species is:

GROUP I, SPECIES I - Fig. 1;

GROUP I, SPECIES II - Fig. 6;

GROUP I, SPECIES III - Fig. 7;

OR

GROUP I, SPECIES IV - Fig. 13.

The species are independent or distinct because:

SPECIES I (i.e., Fig. 1) discloses an insulating element (10) having a plurality of dovetail formations in both long side walls (4, 5) and U-shaped recesses (15, 16) in both end walls.

SPECIES II (i.e., Fig. 6) discloses an insulating element (54) having only one dovetail formation in one of the long side walls and U-shaped recesses (15, 16) in both end walls.

SPECIES III (i.e., Fig. 7) discloses an insulating element (55) having only a plurality of dovetail formations in one of the long side walls and U-shaped recesses (15, 16) in both end walls.

SPECIES IV (i.e., Fig. 13) discloses mating insulating elements (69, 70), wherein both insulating elements have a plurality of dovetail formations in both long side walls, but one end wall of one of the insulating elements (69) has a U-shaped protrusion (76) whereas the opposing end wall of the other of the insulating elements (70) has a U-shaped recess (75).

The SECOND GROUP OF SPECIES (i.e., species of method of making composite building/construction element) from which Applicants must elect a single species is:

GROUP II, SPECIES I - molding matrix around insulating element (e.g., claims 43 and 45);

OR

GROUP II, SPECIES II - molding insert with block (e.g., claim 50).

The species are independent or distinct because the methods have mutually exclusive steps.

The THIRD GROUP OF SPECIES (i.e., species of material for insulating element) from which Applicants must elect a single species is:

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GROUP III, SPECIES I - polystyrene;

GROUP III, SPECIES II - foaming polyurethane;

GROUP III, SPECIES III - foamed rubber;

GROUP III, SPECIES IV - foamed concrete;

GROUP III, SPECIES V - vermiculite glued so as to make a board;

GROUP III, SPECIES VI - fly ash glued together;

GROUP III, SPECIES VII - low density mineral products;

OR

GROUP III, SPECIES VIII - organic inserts;

The species are independent or distinct because the material for the insulating element are mutually exclusive.

If Applicants elect GROUP III, SPECIES VIII above, then Applicants must also elect a SUBSPECIES from the following:

GROUP III, SPECIES VIII, SUBSPECIES I - low density sawdust glued so as to make a board;

GROUP III, SPECIES VIII, SUBSPECIES II - straw or other grass-like materials;

OR

GROUP III, SPECIES VIII, SUBSPECIES III - rice husks glued together into a board or matted insert.

The subspecies are independent or distinct because the material for the insulating element are mutually exclusive.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, independent claims 1, 20, and 37 appear to be generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

A telephone call to Applicants to request an oral election to the above Restriction Requirement and Election of Species Requirement was not made due to the complexity of the election.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gay Ann Spahn whose telephone number is (571)-272-7731. The examiner can normally be reached on Monday through Friday, 10:30 am to 7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard E. Chilcot can be reached on (571)-272-6777. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gay Ann Spahn

Gay Ann Spahn, Patent Examiner
June 25, 2007